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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,297	11/02/2001	Katsuji Maehara	010843	5225

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EXAMINER

SAUCIER, SANDRA E

ART UNIT PAPER NUMBER

1651

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/869,297**

Applicant(s)  
**Maehara et al.**

Examiner  
**Sandra Saucier**

Art Unit  
**1651**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 17, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-46 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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#### DETAILED ACTION

Claims 25-46 are pending and are considered on the merits.

#### *Election/Restriction*

Applicants' arguments concerning the special technical feature of the claims is persuasive and all embodiments are rejoined.

#### *Information Disclosure Statement*

The European search report was considered. However, it was line through because it is not considered to be a publication and is therefore, not suitable to appear on the face of a patent as a reference.

#### *Claim Rejections - 35 USC § 112*

##### INDEFINITE

Claims 25-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 is indefinite because it recites "of the general formula". Either the compound has the formula (2) or it has a different formula which cannot be determined. The metes and bounds of the claims are uncertain. Please use "of the formula (2)".

Claim 25 is not in active language which is appropriate for a method claim such as "comprising, crystallizing". Please revise.

Claim 28 is indefinite because it recites "represented by the following general formula". Either the compound has the formula (1) or it has a different formula which cannot be determined. The metes and bounds of the claims are uncertain. Also X is not defined.

Claims 28 and 29 use the term "dominant". This is not a chemical term and is uninterpretable in the context of the claim.

Claim 32 likewise uses "of the following general formula". See remarks above.

Claims 32, 35-38 and use "is obtainable by diastereo-selective reduction etc.". This does not appear to further limit the preceding claim as the compound is always obtainable by diastereo-selective reduction of compound 3. Perhaps it

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is meant that the compound 2 IS OBTAINED from compound 3.

Claims 39 and 40 are not interpretable as it recites "giving the mixture" which doesn't have a precedent in claim 35.

Claim 41 refers to a solvent in claim 30. However, the solvent in claim 30 is not an aromatic hydrocarbon, but an aliphatic one. This claim lacks precedent in claim 30.

Claim 43 states that the aliphatic hydrocarbon is methylcyclohexane. However, methylcyclohexane is not an aliphatic hydrocarbon. Please delete.

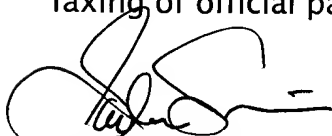
Claim 45 recites "of the general formula" twice. Please see remarks above concerning this phrase.

Because of the multiple dependencies of the claims, it is difficult to understand the order in which they are performed. Please try to clarify the claims so that prosecution is shortened.

The claims appear to be free of the art.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier  
Primary Examiner  
Art Unit 1651  
February 27, 2003